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REMARKS

Claims 26-41 were pending in the Application. By the present reply, the Applicant has presented new Claims 42-46 and respectfully requests their inclusion in the Application. Accordingly, Claims 26-46 are currently pending.

By the Office Action, Claim 26 and its dependent Claims 27-34, 38, 40 and 41 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,682,596 (Bales '596). Similarly, Claims 26 and dependent Claims 27-34, 37 and 39-41 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,454,809 (Jansen '809).

Also, by the Office Action, Claims 26-41 were rejected under the judicially created doctrine of double patenting as being unpatentable over Claims 1, 14, 17, 18, 20, 40-45 of U.S. Patent No. 5,697,909 (Eggers '909). In citing the double patenting rejection, the Office Action advised that a timely filed terminal disclaimer in compliance with 35 U.S.C. §1321(c) may be used to overcome this rejection.

Further, by the Office Action, Claim 36 was rejected under 35 U.S.C. § 112, second paragraph for being indefinite for the reason stated therein.

Regarding the rejections under 35 U.S.C. §102, Claim 26 is amended to define a shaft having a rigid distal end portion and a first electrode terminal disposed at the tip of the rigid distal end portion to define a distal point. Support for these amendments can be found, for example, at page 17, lines 10-11 (rigid shaft) and page 9, lines 18-19 (distal point) of the specification as filed.

Claim 26 is also amended to clarify that the electrodes are adapted for connection to a power supply as disclosed for example at page 19, lines 31-33.

Thus, since neither Bales '596 nor Jansen '809 either discloses or suggests the Applicant's claimed instrument comprising a shaft with a rigid distal end portion with a distal end point, therefore Claim 26 as amended and its dependent Claims 27-46, define a patentable invention over Bales '596 and Jansen '809.

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In particular since Bales '596 discloses and is concerned with a catheter device for insertion into a blood vessel for manipulation and positioning proximate to atherosclerotic plaque or unwanted tissue in the blood vessel, Bales' device inherently is not rigid and is not pointed, but Bale's device is in fact a device comprising a rounded, beveled or chamfered nose (25) on the distal end portion of the shaft (see Col. 5, lines 22-28 and Figs. 1-6)) designed to avoid puncturing the blood vessel and other body members, unlike the Applicant's claimed invention.

Similarly, since Jansen '809 discloses and is concerned with a catheter for insertion within and along the lumen of a tubular body member for manipulation therethrough to a desired position the Jansen's device, like Bales', does not disclose nor suggest the Applicant's claimed device since Jansen's device is not rigid nor pointed but is in fact is device comprising a flexible, flat distal end surface 22 (see Col 5, lines 13-15 and Fig 2 and 7) designed also to avoid puncturing blood vessels and other body into which it is inserted.

Further, the Applicant's claimed invention is not otherwise disclosed or suggested by Bales '596 or Jansen '809 because, unlike the Applicant's claimed device, both of the references disclose devices that define an open orifice at their respective distal end portion designed to enable the devices to accommodate a guide wire for stiffening the devices and for guiding their respective tip member to a desired site in a blood vessel. See for example, Bales '596 at Col 9, lines 59-65.

Regarding the rejection of Claim 36 under 35 U.S.C. § 112, second paragraph, this claim has been amended to clarify that the fluid delivery element comprises a fluid supply instrument as disclosed, for example, in Fig. 3.

The other amendments shown in Claims 26-41 are formal, including punctuations, to better define the claimed invention.

Regarding new Claims 42-46, support for Claim 42 can be found, for example, at page 9, lines 6-8; support for Claim 43 can be found, for example, at page 13, lines 7-12; support for Claim 44 can be found, for example, at page 17, lines 29-32 and page 29, line 1-2; support for Claim 45 can be found for example at page 23, lines 18-21; and support for Claim 46 can be found at page 29, lines 5-11.

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Accordingly, since the claims as amended are not disclosed nor suggested by the cited references, and since the present amendments and new claims are supported in the specification as filed, the Applicant respectfully request reconsideration and allowance of the claims.

Regarding the double patenting rejection, the Applicant intends to file a timely terminal disclaimer, as advised in the Office Action, should the claims are found otherwise allowable, and this rejection is still maintained.

SUMMARY

By the present amendments the Applicant believes that the bases for rejections as set for in the Office Action have been addressed and that, with the newly added claims, the Application is in condition for allowance. The Applicant therefore respectfully requests reconsideration of the claims and the allowance of the Application. If any issue is still outstanding and the Examiner feels that a telephone conference would expedite prosecution of the Application, kindly telephone the undersigned at (408) 736-6486.

Respectfully submitted,



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